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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/646,013	11/06/2000	Angus Peter Robson	08059.0005	1928

7590

11/05/2003

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EXAMINER

ROSENBAUM, MARK

ART UNIT PAPER NUMBER

3725

DATE MAILED: 11/05/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/646,013

Applicant(s)

ROBSON, ANGUS PETER

Examiner

Mark Rosenbaum

Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4/1, 6-8, 10-28 is/are rejected.
- 7) ☒ Claim(s) 2, 3, 4/2, 4/3, 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 10/9/03 have been fully considered but they are not persuasive.. First, applicant states that Liebing is non-analogous art to applicant's crusher and tries to prove this by quoting from Liebing 'employed for crushing tasks...'; see page 3, lines 3-6 of the newly filed amendment. How can this be evidence that it is non-analogous art when applicant clearly states that Liebing is for '**crushing tasks**'? Applicant's apparatus provides a crushing operation also i.e. why would **anyone skilled in the art** consider Liebing to be non-analogous art? The next argument states that Liebing does not solve applicant's problem and thus there is no need for the proposed combination of references. This is also incorrect because where the subject matter of a claim is obvious for the purpose of the reference, the substance of the claim becomes obvious to one skilled in the art for a significant purpose, and it is immaterial as to patentability under 35 USC 103 that applicant has another purpose; in re Graf, 145 USPQ 197. Applicant continues his arguments by stating that the rotor of Liebing is not adjustable. A careful reading of Liebing shows that applicant's characterization of Liebing is simply wrong. In column 2, lines 7-19, Liebing states that it is preferable to have the housing adjusted as opposed to the rotor, which means that it is also possible to have the rotor adjustable if desired. The use of the word 'preferable' does not preclude the rotor itself from being adjustable. Concerning the use of a layer of material on the mill interior surface for wear purposes, the examiner stated that this is well known to **anyone skilled in the art** and thus a reference need not be provided to show

such a feature. However, at applicant's request, references well known in the art have been provided to show this feature. Finally, it is noted that the dependent claims have not been separately argued such that their patentability stands or falls with the parent claims.

Claim Rejections - 35 USC § 103

Claims 1,4/1,6,27 are rejected under 35 U.S.C. 103(a) as being unpatentable over APA in view of Liebing. See paper number 14 for this rejection.

Claims 10-13,16-26,28 are rejected under 35 U.S.C. 103(a) as being unpatentable over APA in view of Liebing as applied to claim 1 above, and further in view of Wood. See paper number 14 for this rejection.

Claims 7,8,14,15 are rejected under 35 U.S.C. 103(a) as being unpatentable over APA in view of Liebing as applied to claim 1 above, and further in view of either Okuhara or Canada. The basic combination does not have a material layer on the mill interior surface which may lead to premature wear of the surface. Both Okuhara (15) and Canada (14) solve this problem by disclosing similar apparatus including the use of a material layer within the mill. In order to prevent premature wear, it would have been obvious for one of ordinary skill in the art at the time of the invention to modify APA by providing a material wear layer, taught to be desirable by both Okuhara and Canada.

Allowable Subject Matter

Claims 2,3,4/2,4/3,9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Rosenbaum whose telephone number is 703-308-1788. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Ostrager can be reached on 703-308-3136. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Mark Rosenbaum

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Primary Examiner
Art Unit 3725

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